

Turning first to the legal error, Applicants wishes to remind the Office of the bedrock legal principles for rejecting a claim under 35 U.S.C. § 103. Specifically, in In re Rouffet, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) the Federal Circuit explained:

To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.

Id. at 1455 (citations omitted and emphasis added).

In the Rouffet case, the Examiner had rejected the pending claims on a combination of references. The Board sustained the Examiner. However, the Federal Circuit reversed the Board's decision and ruled that the Examiner's rejections were legally impermissible because they failed to demonstrate a suggestion for combining the references in the manner proposed by the Examiner. As explained by the Federal Circuit:

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

Id. at 1457-58 (citations omitted and emphasis added).

These principles have not been followed in rejecting claims 1 and 31. Merely stating an advantage or possible advantage of combining references or merely that one reference has

certain advantageous properties, as was done to reject claims 1 and 31 is not the same as “show[ing] a motivation to combine the references.”

On the contrary, in order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a *prima facie* case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, for example, Ecocochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065, 1072-73 (Fed. Cir. 2000) and In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999). Indeed, the law is quite clear that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness *must be supported by facts*. Where the legal conclusion is not supported by facts it cannot stand.

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967). This longstanding principle has been followed to date. For example, in the unpublished Board decision, Ex parte Megens, App. No. 1999-0277 (B.P.A.I. Oct. 29, 1999), the Board stated:

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts, that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

The examiner’s conclusion that it would have been obvious to incline Phillips’ loading dock floor 65 rests on the completely unfounded assumption that it would be desirable to drain liquid from the floor. The Phillips reference, however, is devoid of any indication that liquid might accumulate on the floor or that such

accumulation would pose a problem even if it did occur. It is therefore apparent that the examiner has resorted to improper speculation and hindsight reconstruction to overcome the admitted deficiency of Phillips vis-à-vis the subject matter recited in claim 1.

(Megens at Pages 4-5)(emphasis added).

This is precisely the situation presented here. The “suggestion” in support of the rejection of claims 1 and 31 amounts to nothing more than a speculative statement that, given the alleged presence of the claim elements in the prior art and an advantage that combining these elements would allegedly achieve, a person skilled in the art would have found it obvious to combine the references to create the claimed invention. The problem with this approach is that it effectively eliminates the requirement of identifying a suggestion for combining references from the obviousness analysis. More specifically, the analysis present in the Office action proceeds in the following manner:

- a) What elements are present in the pending claims?
- b) Can these elements be found in prior art references?
- c) If they can be found, and the references themselves provide no suggestion for combining these elements, can some end or advantage be identified to combine the elements in the manner proposed in the Applicants’ claims?
- d) If so, combine the elements in the manner proposed by the Applicants and reject the pending claims.

This mode of analysis is, of course, deeply flawed. Specifically, as noted by the Federal Circuit in the Rouffet quote identified above, all of the elements of most claimed inventions can almost always be found in the prior art. Therefore, the answer to step “b” above will almost

always be "yes". Since it is a statutory requirement that all inventions have utility, there will also always be an identifiable end or advantage in combining the elements in the prior art in the manner proposed by any claim (e.g., if there was no purpose to an element in a claim it would not be included in the claimed apparatus, after all, who would pursue a claim with superfluous elements or a claim with no utility?). Therefore, if the "suggestion" requirement of 35 U.S.C. § 103 can be met by merely identifying any end or advantage which will be achieved by combining the elements of the prior art references, the suggestion requirement can always be met and is utterly meaningless.

This inherent flaw in the analysis employed in rejecting claims 1 and 31 is elucidated by viewing the alleged "suggestion" the Office action identifies in support of the rejection. As noted above, in rejecting claims 1 and 31, the Office action states: "Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the wireless communication system of Ward with the teaching of Tong in selecting carrier(s) for transmission between a base station and mobile users in accordance based on the classes of services and data rates required such that Ward will transmit the multicarrier communication signal and select sub-carrier(s) of the one or more sub-carriers comprising the multi-carrier communication signal for transmission with the user based upon the class type. The motivation to do so is to optimize the operation of the cell sector serviced by the carriers by meeting the minimum grades of service for the users and maximizing the multicarrier throughput." The first part of the statement, namely, "It would have been obvious ... to employ" is merely boilerplate language that does not address the suggestion requirement. The second part of the statement, namely, "to combine the wireless communication system of Ward with the teaching of Tong in selecting carrier(s) for transmission between a base station and mobile users in accordance based

on the classes of services and data rates required such that Ward will transmit the multicarrier communication signal and select sub-carrier(s) of the one or more sub-carriers comprising the multi-carrier communication signal for transmission with the user based upon the class type” simply states what the proposed modification of the primary reference is to be. This second part of the statement, thus, describes the proposed modification, but offers no explanation of a motivation for making that modification. The final part of the statement, namely, “The motivation to do so is to optimize the operation of the cell sector serviced by the carriers by meeting the minimum grades of service for the users and maximizing the multicarrier throughput” is obviously considered the motivation.

However, while it is true that possible advantages may include to optimize the operation of the cell sector serviced by the carriers by meeting the minimum grades of service for the users and maximizing the multicarrier throughput, that is not a suggestion in and of itself. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)(emphasis added). Here, the Office action does not identify any evidence in the prior art indicating or in any way suggesting the desirability of the proposed modification. It only identifies an old element that has an inherent property. Indeed, the Office action’s naked, conclusory statement amounts to nothing more than stating: A person of ordinary skill in the art would be motivated to combine the cited art because they would want to gain a benefit from combining the cited art. Of course, such circular reasoning (i.e., add “X” to have “X”) cannot be a legally proper tool for identifying a suggestion for combining references. If it were, no combination of old elements would ever be patentable since one can always nakedly state, a person would be motivated to add old element X from one

reference to another reference because adding element X offers an advantage (again, if adding "X" had no advantage, who would ever claim it?). Simply put, there is *always* an advantage to combining old elements that can be identified through hindsight *once that combination is known*. It should be quite clear from the above that merely identifying an advantage for adding an old element to a combination of elements is not a proper suggestion for making that combination. The MPEP further proves this point. In particular, MPEP § 2144 states that "the strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent, that some advantage would have been produced by their combination." The MPEP cites In re Sernaker, 702 F.2d 989, 994-95 (Fed. Cir. 1983) to support this proposition.

Looking at the Sernaker case, we see that the Federal Circuit states: "The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Sernaker, 702 F.2d at 995-96 (emphasis added). Notice that this statement does not state that it is obvious to combine references simply because there is an advantage to doing so. On the contrary, it carefully states that there can be no obviousness ruling unless something in the art suggests an advantage to combining the references. The advantage itself is not the suggestion, but rather the Court makes it clear that something else suggests the advantage.

The MPEP quote noted above is similar. It states that the "strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent that some advantage or expected beneficial result would have been produced by their combination." (MPEP, Page 2100-127) (emphasis added). This, of course,

does not state that the strongest rationale for combining references is the mere presence of an advantage to doing so. Instead, as in Sernaker, the strongest rationale is a recognition (i.e., a suggestion) in the art that an advantage will result.

Turning back to the rejections at issue, rather than identifying something in the art that suggests an advantage to making the combination, the Office action just looks for the advantage itself and mislabels that advantage as “suggestion.” As explained above, this is a literal elimination<sup>1</sup> of the suggestion requirement. Since there is always an advantage to a claimed element (or why would you claim it?), the Office action’s misplaced view of an advantage as the suggestion inherently renders all combinations of old elements unpatentable precisely because it eliminates the suggestion requirement from the analysis. Clearly, neither the MPEP section noted above nor the Sernaker case upon which that MPEP section rests for authority stands for the proposition that an advantage of an element is a suggestion in and of itself for including that element in a combination.

In view of the foregoing, Applicant respectfully submits that the §103 rejection of claims 1 and 31 and claims that depend therefrom must be withdrawn because it fails to identify a legally proper suggestion for combining the prior art references in the manner proposed by the Office action. In other words, the Office has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. On this basis alone, the rejections of claims 1 and 31 and all claims depending therefrom must be withdrawn. Further, for the reasons set forth above, Applicant respectfully submits that the rejection of independent claim 30 has been traversed as well.

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<sup>1</sup> It literally removes the “recognition” portion of the MPEP quote above and the “something in the art” portion of the Sernaker quote.

**CONCLUSION**

In light of at least the foregoing amendments and remarks, Applicant respectfully submits that claims 1 and 31 are in condition for allowance and such action is earnestly solicited. ***The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.***

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Respectfully submitted,

Date: April 30, 2007 by: /s/James S. Finn/Reg. No., 38,450/

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